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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,331	09/11/2003	Bogie Boscha		3771
51896	7590	03/22/2007	EXAMINER	
ILYA ZBOROVSKY 6 SCHOOLHOUSE WAY DIX HILLS, NY 11746			HOEL, MATTHEW D	
		ART UNIT	PAPER NUMBER	
		3714		
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/22/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/659,331	BOSCHA ET AL.	
	<b>Examiner</b> Matthew D. Hoel	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 28 December 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 75-79 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 75-79 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 75 to 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuer, et al. (U.S. pre-grant publication 2002/0077189 A1, application 10/016,965) in view of Konow (U.S. pre-grant publication 2003/0008722 A1, application 10/118,527).

4. Regarding claims 75, 77, and 79, Tuer et al teaches a system comprising a putter having a handle, a head (¶0026), and sensing means selected from the group consisting of acceleration measuring means, deceleration measuring means (¶0025), putter path measuring means (¶0038: 4), rotation measuring means, lie angle measuring means, a loft angle measuring means (¶0025), and combinations thereof; means for transmitting data measured by said measuring means (¶0033); computing

means for receiving and processing of measured data (¶¶0027, 0028, 0031, 0034); and display means for displaying the processed data so that a golf player can analyze his performance (¶0034). It would be simple and logical to one of ordinary skill in the art to attach some type of identifying number for each player when using the golf club, and Tuer et al is very capable of doing so with the components disclosed; however, Tuer et al lacks in disclosing an identification of the club by a serial number in order to distinguish between other clubs. Konow teaches an electronically traceable golf club in which a transponder is encoded with a specific identification such as a multi-digit code or serial number (¶0011). The object of this invention is to provide a registration system that can be incorporated in a transportable object that will identify that object for purposes of data base comparisons, thus it would have been obvious to one of ordinary skill in the art to add a transponder to each golf club of Tuer et al in order to identify each club individually. In addition to identifying users and user data, this type of identification may be used for determining theft of the device and its whereabouts after theft or its whereabouts during shipping. Although the transmission of the serial number unique to a putter is not explicitly taught by the prior art, the examiner believes there is sufficient suggestion in the prior art and motivation of the knowledge of one of ordinary skill in the art to include this limitation. Tuer teaches in his Abstract that the instrumented golf club may use Bluetooth to transmit the golf swing information to the computer. All Bluetooth packets inherently contain an address unique to each Bluetooth device. The examiner points the applicants to the Bluetooth specification published by the Institute of Electrical and Electronics Engineers (IEEE), Dec. 1<sup>st</sup>, 1999

([http://grouper.ieee.org/groups/802/15/Bluetooth/profile\\_10\\_b.pdf](http://grouper.ieee.org/groups/802/15/Bluetooth/profile_10_b.pdf), downloaded Mar. 14<sup>th</sup>, 2007). Each Bluetooth device has a 48-bit address (Page 25). One of ordinary skill in the art also would have been motivated to make this limitation because a typical golfer is known to carry several clubs in his or her golf bag (for example, three woods, two wedges, a putter, and eight irons (for example, 3, 4, 5, 6, 7, 8, and 9 irons, plus a pitching wedge). See "KISS Guide to Playing Golf," by Steve Dunno, © 2000, DK Publishing, Inc., Pages 85, 96, and 103 to 105 for a typical assortment of golf clubs. A golfer would want to have a swinging profile for each of the several golf clubs he or she typically uses. Konow in Para. 4 of the background also suggests registering golf clubs at the factory for theft prevention purposes. A unique transmitted serial number from each golf club would clearly serve to fill such a purpose, much as the Lojack ™ system does for automobiles. A further motivation could open up the option of selling the device to golf courses/clubs, which they may rent to their players and track where each player is and there progress from tee to tee.

5. Regarding claims 76 and 78, Tuer et al teaches a system wherein said putter (type of golf club) has means for transmitting the measured data from the putter to the computing means (¶0033, 0034).

### ***Response to Arguments***

6. Applicant's arguments filed 12-28-2006 have been fully considered but they are not persuasive. The claims have been assigned a priority date of 9-11-2003, as there was no support for the transmission of a serial number in 60/442,548, 09/920,529, or

Art Unit: 3714

09/858,829. The specification in 60/473,317 pertained to an unrelated case, so the examiner could not establish support for this limitation in this provisional. The examiner requests the applicant to inform him if this provisional application number might be wrong. While the transmission of serial numbers by instrumented golf clubs is not explicitly taught by the references, the examiner believes that this transmission would be inherent as the Bluetooth protocol assigns a unique address to each device, and it would be obvious to do this limitation as identifying golf clubs would be useful for developing a swing profile for each golf club (woods, irons, wedges, and putters) and for the security reasons suggested by Konow in his background. Although the transmission of the serial number unique to a putter is not explicitly taught by the prior art, the examiner believes there is sufficient suggestion in the prior art and motivation of the knowledge of one of ordinary skill in the art to include this limitation. Tuer teaches in his Abstract that the instrumented golf club may use Bluetooth to transmit the golf swing information to the computer. All Bluetooth packets inherently contain an address unique to each Bluetooth device. The examiner points the applicants to the Bluetooth specification published by the Institute of Electrical and Electronics Engineers (IEEE), Dec. 1<sup>st</sup>, 1999 ([http://grouper.ieee.org/groups/802/15/Bluetooth/profile\\_10\\_b.pdf](http://grouper.ieee.org/groups/802/15/Bluetooth/profile_10_b.pdf), downloaded Mar. 14<sup>th</sup>, 2007). Each Bluetooth device has a 48-bit address (Page 25). One of ordinary skill in the art also would have been motivated to make this limitation because a typical golfer is known to carry several clubs in his or her golf bag (for example, three woods, two wedges, a putter, and eight irons (for example, 3, 4, 5, 6, 7, 8, and 9 irons, plus a pitching wedge). See "KISS Guide to Playing Golf," by Steve

Dunno, © 2000, DK Publishing, Inc., Pages 85, 96, and 103 to 105 for a typical assortment of golf clubs. A golfer would want to have a swinging profile for each of the several golf clubs he or she typically uses. Known in Para. 4 of the background also suggests registering golf clubs at the factory for theft prevention purposes. A unique transmitted serial number from each golf club would clearly serve to fill such a purpose, much as the Lojack™ system does for automobiles. The examiner notes that the serial number transmission is only supported by Para. 41 and Fig. 2 of the specification leaving little room to elaborate on this limitation in future amendments. The examiner invites the applicants to search the specification for limitations not fairly suggested by the previously cited references, but a cursory review yields no suggestions. The examiner respectfully disagrees with the applicants as to the claims' current condition for allowability.

***Citation of Pertinent Prior Art***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Bluetooth specification published by the Institute of Electrical and Electronics Engineers (IEEE), Dec. 1<sup>st</sup>, 1999 ([http://grouper.ieee.org/groups/802/15/Bluetooth/profile\\_10\\_b.pdf](http://grouper.ieee.org/groups/802/15/Bluetooth/profile_10_b.pdf), downloaded Mar. 14<sup>th</sup>, 2007) lists a unique identifier for each Bluetooth device. 09/332,466, published as 7,004,848 or 2003/0008722, establishes a 102(e) priority date for a golf club very similar to the applicants' specification. Register in U.S. patent 6,118,376 A teaches golf clubs with identification transponders. Boley, et al. in U.S. patent 6,023,225 A teach golf

clubs with identification transponders. Donnelly in U.S. patent 5,952,921 A teaches golf clubs with identification transponders. Konow in U.S. pre-grant publications 2003/0008722 A1 and 2006/0122002 A1 and patent 7,004,848 B2 teaches traceable golf clubs.

### ***Conclusion***

8. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

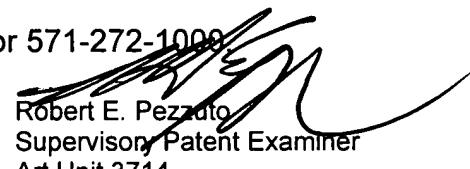
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Hoel whose telephone number is (571) 272-5961. The examiner can normally be reached on Mon. to Fri., 8:00 A.M. to 4:30 P.M.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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AU 3714

  
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